



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,408	04/24/2001	Nick Merz	APLIP202/P2625	9091

22434 7590 04/04/2003

BEYER WEAVER & THOMAS LLP  
P.O. BOX 778  
BERKELEY, CA 94704-0778

EXAMINER

LEA EDMONDS, LISA S

ART UNIT	PAPER NUMBER
----------	--------------

2835

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/842,408

Applicant(s)

MERZ ET AL.

Examiner

Lisa Lea-Edmonds

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 and 38-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 1-24 and 37-59 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 1-11 are drawn to computing device with LCD shock mount; claims 12-24 are drawn to portable computer with optical drive and shock mount; and claims 37-59 are drawn to portable computer with cooling.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-24 and 37-59 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 12/07/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, and only the U.S. patents referred to therein has been considered. Applicant is requested to send in a legible copy of "Panasonic Toughbook 28". The examiner of record cannot consider the "Toughbook 28" without a copy to consider.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to

Art Unit: 2835

enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 25-36 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a portable computer comprising a base having a casing and a chassis, does not reasonably provide enablement for an enclosureless optical disk drive. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. Applicant has claimed an enclosureless optical disk drive (CD/DVD), however, applicant has disclosed and claimed an optical disk drive having an enclosure in that the optical disk drive has a frame component (248) having a base member (25) and a top cover (525) see for example figure 5.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25-28, and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima (5715139) in view of Forlenza et al. (6392880). With respect to claims 25-28 and 32-36, as best understood, the apparatus of Nakajima teaches a portable computer (1) comprising a base (2) having casing (4, 5, 6) and a chassis (70) wherein the casing (4, 5, 6) is configured to house various components that provide computing operations for the portable computer (1) and the chassis (70) includes a plurality of ribs (74a, 74b, 75, 76) wherein at least

Art Unit: 2835

one of the ribs (74a, 74b, 75, 76) forms a wall of the enclosed region and is configured to support the casing (4, 5, 6), the casing (4,5,6) and chassis (70) has interior portions that define an enclosed region inside the base (2); shield plates (78, 100, 101); and a disk drive (50) as claimed (see for example figures 1-47 with focus on figures 11-19 and column 6 line 39 through column 30 line 25). However, the apparatus of Nakajima lacks a clear teaching of an enclosureless optical disc drive as claimed. The apparatus of Forlenza et al. is relied upon for its teaching of an enclosureless optical disc drive (88) having drive components and frame components configured to support the drive components, as claimed (see for example figure 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Forlenza et al. into the apparatus of Nakajima as providing a user with the most up-to-date disk drive system is mere routine in the art and would be considered a design choice. The apparatus of Nakajima as modified by Forlenza et al. teaches the casing (4, 5, 6) and chassis (70) include a top wall for enclosing a top portion of the enclosureless optical disc drive (88), a bottom wall for enclosing a bottom portion of the enclosureless optical disc drive (88), a front wall for enclosing a front portion of the enclosureless optical disc drive (88), a first side wall for enclosing a first side portion of the enclosureless optical disc drive (88), a second side wall for enclosing a second side portion of the enclosureless optical disc drive (88), and a back wall for enclosing a back portion of the enclosureless optical disc drive (88); wherein the internal portions of the casing (4, 5, 6) and chassis (70) that form the enclosed region are configured to shield electronic emissions therein; wherein the chassis (70) is disposed within the portable computer enclosure; wherein the enclosed region shields the enclosureless optical disc drive from dust; wherein the enclosed region shields laser emissions; and wherein the optical disk drive is a CD/DVD drive as claimed. With respect to claim 36, it would have been obvious to one skilled in the art to select a slot

Art Unit: 2835

loaded CD/DVD drive as the apparatus of Nakajima has a slot (54) for loading a disk therein.

One skilled in the art would not be motivated to destroy the slot structure of Nakajima to provide the portable computer (1) with a tray loaded CD/DVD drive.

3. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima as modified by Forlenza et al. as applied to the claims above, and further in view of Chee et al. (6324054). With respect to claim 29 as best understood, the apparatus of Nakajima as modified by Forlenza et al. teaches the claimed invention as set forth above. However, Nakajima as modified by Forlenza et al. lacks a clear teaching of a thin flexible boot as claimed. The apparatus of Chee et al. is relied upon for its teaching of a thin flexible boot (300) as claimed (see for example figures 3, 4, and 8-15). It would have been obvious to one having ordinary skill in the art to incorporate the teachings of Chee et al. into the apparatus of Nakajima as modified by Forlenza et al. to provide the disk drive with shock absorbers.

4. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima as modified by Forlenza et al. as applied to the claims above, and further in view of Smith et al. (6122167). With respect to claim 31 as best understood, the apparatus of Nakajima as modified by Forlenza et al. teaches the claimed invention as set forth above. However, Nakajima as modified by Forlenza et al. lacks a clear teaching of the internal portions of the casing and chassis that form the enclosed region are configured to shield electronic emissions as claimed. The apparatus of Smith et al. is relied upon for its teaching of an EMI shield that surrounds a component. It would have been obvious of one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Smith et al. into the apparatus of Nakajima as modified by Forlenza et al. to protect the user from EMI transmissions.

***Respons to Arguments***

5. With respect to applicant's remarks dated 02/05/03 concerning claims 25-28 and 32-36 (103 rejection in view of Nakajima et al., Forlenza et al., and Chee et al.), the examiner of record has fully considered applicant's remarks. It appears to the examiner of record that primary basis for applicant's remarks are the prior art of record failing to teach or suggest "an enclosureless optical disk drive" as claimed. It is the position of the examiner of record that applicant, himself does not teach nor fairly suggest an "enclosureless" optical disk drive, in that applicant states that "By enclosureless, it is meant that the CD/DVD drive does not include its own housing...", however applicant goes on to state that the "enclosureless" optical disk drive has a frame component, a top plate, and a bottom plate. As defined by Merriam Webster's Collegiate Dictionary 10<sup>th</sup> Ed. enclosure as the act or action of enclosing; enclose as to close in: surround: to hold in: confine; and less as constituting a more limited number: to a lesser extent or degree: diminished by: minus. Given the definitions above, one can see how applicant lacks a teaching of an "enclosureless" optical disk drive (that is an optical disk drive minus an surrounding or anything to "hold or confine" it). With this point of view, it is the position of the examiner of record that the above rejection stands in so much as applicant has failed to teach or fairly suggest an "enclosureless" optical disk drive.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please note the portable computers with EMI shielding of LaPonite et al. and Hulsebosch.

Art Unit: 2835

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Lea-Edmonds whose telephone number is 703-305-0265. The examiner can normally be reached on 6:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1782.

Lisa Lea-Edmonds  
Examiner  
Art Unit 2835

April 1, 2003

A handwritten signature in cursive script, appearing to read "Lisa Lea-Edmonds", written in black ink.